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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,135

Applicant(s)

Jun Fujimoto

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 1, 1999 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). OPY Pg 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed June 6, 2001 (Paper No. 14) is acknowledged. Accordingly, claims 28-55 remain pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings are replete with these errors. Some examples follow. Applicant is reminded no new matter is allowed. The following examples must therefore be shown or the features canceled from the claims:

- a. The “retrieving said third data of said purchaser” as recited in claim 28
- b. The “performing an accounting operation” as recited in claim 28.
- c. The “recording a price information” as recited in claim 39.

3. The Examiner notes the claims are replete with the above drawing errors. In fact, the application contains only one flow chart (Figure 7). All method steps recited in claim 28-55 are clearly not shown in figure 7. The Examiner highly recommends Applicant review all 28-55 claims to ensure that every method step recited is shown in the drawings. To show no new matter is found in the drawings, the Examiner respectfully requests Applicants to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are

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required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 42-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter., 1990). Applicant is claiming a method in claim 28 and a system in claim 42 since claim 42 recites in part, “wherein said data providing system comprises”

Claim 28 is clearly directed towards a the statutory class of a process.¹ Additionally, “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). And, “Claims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)

¹ See 35 U.S.C. § 101 (1994) (“Whoever invents or discovers any new and useful process . . . may obtain a patent therefor.”); and 35 U.S.C. § 100(b) (1994) (“The term ‘process’ means process, art or method”).

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(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore system claims 42 and its dependent claims are clearly machine claims.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

7. Claims 28-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are still replete with errors. Some examples follow:

a. Claim 28 recites the limitation “said purchaser rewritable record medium” in line 8. There is insufficient antecedent basis for this limitation in the claim. It is the Examiner’s position that the “purchaser rewritable record medium” is different from the “purchaser rewritable medium” as recited in line 3.

b. Also in claim 28, the phrase “in a case that said third data which is retrieved” is unclear since line 6 already claims “retrieving sad third data” Therefore third Therefore data is retrieved in *all* cases.

c. Claim 34 is unclear since the clause “wherein said performing said accounting operation” is a hanging clause. The claim sentence does not make grammatical sense. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983).

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d. Claims 29-38 and 40-55 are indefinite because the claims fail to recite any additional method steps. While the claims need not recite all of the operating details, a method claim should at least recite a positive, active step. *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (B.P.A.I. 1987) (citations omitted).

e. In claim 32, the “tile information” is unclear and indefinite.

f. Claim 42-55 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Because the claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention, it is unclear whether Applicant is claiming a process or a machine. Again, see MPEP §2173.05(p) II and the §101 rejections above.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

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9. Claims 28-39, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et. al. (U.S. 6,129,274). Suzuki et. al. discloses the following: retrieving said third data of said purchaser (Item decryption, quantity, and price); the third data is registered for every purchaser (every purchaser using the card for a transaction has an item decryption, quantity, and price); the third data is based on second data (second data is customer name, address, ect; the items purchased are based upon the person doing the purchasing); a purchase request is made by a purchaser (who else would make a purchase request?); performing an accounting operation (totaling the items purchased or noting which particular item is purchased); the third data is matched (the POS and the card 10 will have matching information, both will have item description, quantity, and price); first, second, and third data is recorded on card 10 after the after the information is received; the smart card must be registered (it must work with the POS system); purchase information includes data specific information (unless the information is a copy, its always data specific); and including recording price information (inherent).

10. Functional recitation(s) using the word “for” (e.g. “for providing a purchaser with a first data such that . . . said first data can be recorded” as recited in claim 28) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a

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purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

11. For due process purposes, the Examiner notes Applicant has declined the Examiner's express invitation² to be his or her own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Accordingly, for the remainder of the ex parte examination, the presumption in favor of the ordinary and accustomed meaning is maintained and is now made final. The claims are therefore interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).³ The Examiner now relies extensively on this interpretation.

12. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

² See the Examiner's previous Office Action, Paper No. 10, Paragraph No. 11.

³ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 30-39, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et. al.⁴ It is the Examiner's principle position that the claimed methods are inherently disclosed. However, if not inherent, the missing elements in Suzuki et. al. are only found in the nonfunctional descriptive material and are not functionally involved in the steps claimed (i.e. the steps of "recording price information" as recited in claim 39 is in no way dependent upon the content of the information recorded).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Suzuki et. al. with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re*

⁴ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).⁵

Allowable Subject Matter

15. For purposes of appeal only, claims 42-55 are considered allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

It is the Examiner position that the claims are so unclear and have so many §112 2nd paragraph and other rejections (i.e. it not known whether Applicant is claiming a method or a system) that ascertaining what is the claimed subject matter can not be made at this time. Once the §112 2nd paragraph and other rejections are corrected, the claims will then be reevaluated in light of the prior art so as to ascertain their patentability. See MPEP §2173.06.

Response to Arguments

16. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

⁵ See also MPEP §2106 IV B.

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Conclusion

17. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

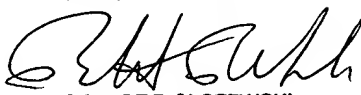
18. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

19. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF
June 19, 2002


ANDREW J. FISCHER
PATENT EXAMINER
6/19/02

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